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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,938	04/06/2000	Dushyant Sharma	39440/199992	7936

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EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary	Application No.	Applicant(s)	
	09/543,938	SHARMA, DUSHYANT	
	Examiner	Art Unit	
	Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,13,17,21-34,38-43,47-55,57-60,62-65 and 71-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,13,17,21-34,38-43,47-55,57-60,62-65 and 71-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 23rd, 2003 has been entered.

Preliminary Amendment

A preliminary amendment has been filed on July 23rd, 2003 in which claim 1-11, 13, 17, 21-34, 38-43, 47-55, 57-60, 62-65, 71-81 have been amended, claims 12, 14-16, 18-20, 35-37, 44-46, 56, 61, 66-70 have been canceled. Claims 1-11, 13, 17, 21-34, 38-43, 47-55, 57-60, 62-65, 71-81 remain pending in the letter.

Response to Arguments

Applicant's arguments with respect to claims 1-11, 13, 17, 21-34, 38-43, 47-55, 57-60, 62-65, 71-81 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

1. Claim 62 is objected to because of the following informalities: Applicant discloses "the preprocessing." Applicant is advised to replace "the" to "a" in order to overcome the Examiner's objection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21 and 62 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 21 and 62 only recites an abstract idea. The recited steps do not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma* (CCPA 197 USPQ 852 (1978)).

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 21 and 62 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-46 and 48-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shutzer (U.S. Patent No 6,292,789) in view of Remington et al (U.S. Patent No 6,070,150).

5. As per claims 1, 21, 38, 40, 47, 49, 51, 62 and 71, Shutzer teaches a system/method for presenting and paying bills (*see abstract, fig 1*) comprising a common document model processing functionality (*bill service provider, 104*) adapted to transform the relevant information into a common document model, which common document model is adapted to accommodate the relevant information from the plurality of billers and according to the plurality of data types (*see figs 1-7, column 14 line 26-15 line 2*), a database adapted to store the transformed information from the common document model processing functionality (*see figs 1-7, column 14 line 26-15 line 2*), and presentation functionality (*bill presentation and payment, 124*) adapted to retrieve information from the database and output at least some of the

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information via a network for use by bill payers (*see abstract, fig 1-5, column 13 line 11-14 line 25*). Shutzer fail to teach parsing/extracing functionality which is adapted to parse billing data from a plurality of billers using rules of conversion according to which the parsing functionality is programmed, corresponding to a plurality of data types and to provide relevant information for further use by the system. However, Remington et al. teach parsing functionality which is adapted to parse billing data from a plurality of billers using rules of conversion according to which the parsing functionality is programmed, corresponding to a plurality of data types and to provide relevant information for further use by the system (*see abstract, fig 5,7-9, column 3 line 35-4 line 65, 7 lines 6-8 line 50*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shutzer's inventive concept to include Remington et al's teach parsing functionality which is adapted to parse billing data from a plurality of billers using rules of conversion according to which the parsing functionality is programmed, corresponding to a plurality of data types and to provide relevant information for further use by the system because this would have given the customer complete control of the payment timing and amount having exclusive authority to make full or partial payment or to forego payment thereby minizing induce errors that would detrimentally slow the bill presentment and payment system.

6. As per claims 2-4, Shutzer teaches a system wherein the parsing functionality is adapted to parse data from a print/interchange/financial stream of data provided by a biller (*see abstract, fig 1-5, column 13 line 11-14 line 25*).

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7. As per claims 5-9, Shutzer teaches a system wherein the presentation functionality is adapted to output information for use by the bill payers using style sheet in order to render information is a suitable form using markup language, is adapted to output information for use by bill payers using or not financial software or browser (*see figs 1-7, column 14 line 26-15 line 2*).

8. As per claims 10, 11, 13, 17, 50, 52, 55, 58, 59, 72, 75, 76, 78, 79, 81, Shutzer teaches a system for presenting and paying bills (*see abstract, fig 1*), comprising interactivity functionality to detect and respond to communication from bill payers by retrieving information from the database and presenting it to a payer in a form requested by the bill payer; and altering information in the database corresponding to the bill payer according to the communications (*see figs 1-7, column 14 line 26-15 line 2*).

9. As per claims 17, 34, 53, 54, 73, 74, Shutzer teaches a system for presenting and paying further comprising a financial source interface adapted to send and receive communication to and from at least one financial entity and to alter information in the database according to the financial source communications (*see figs 1-7, column 14 line 26-15 line 2*).

10. As per claims 22-24, 63-65, Shutzer teaches a system wherein the billing data is extracted from a print/interchange/financial stream of data provided by a plurality of billers (*see abstract, fig 1-5, column 13 line 11-14 line 25*).

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11. As per claims 25-29, Shutzer teaches a system wherein some information is output using the bill payers using style sheet in order to render information is a suitable form using markup language, is adapted to output information for use by bill payers using or not financial software or browser (*see figs 1-7, column 14 line 26-15 line 2*).

12. As per claims 30-33, Shutzer teaches a system further comprising detecting and responding to communication from bill payers by retrieving information from the database and presenting it to a payer in a form requested by the bill payer; and altering information in the database corresponding to the bill payer according to the communications (*see figs 1-7, column 14 line 26-15 line 2*).

13. As per claims 34, Shutzer teaches a system wherein the interface is adapted t allow bill payers to specify the location of the output (*see figs 1-7, column 14 line 26-15 line 2*)

14. As per claims 41-43, 57, 77, Shutzer et al teach a system wherein the biller interface is adapted to allow the plurality of billers to alter the appearance bill presentment and to communicate with payers based on market segments (*see fig 25, column 20 line 16-55*).

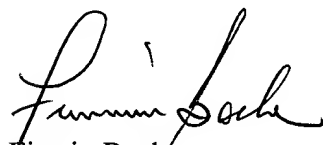
15. As per claim 48, 60, 80, Shutzer et al teach a system further comprising an agent interface coupled to the database to allow agents having agency relationship (*see figs 1-7, column 14 line 26-15 line 2*).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
July 25, 2003